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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,086	07/21/2003	Arthur Ho	D-2895CIP2	6002
33197	7590	06/20/2005	EXAMINER	
STOUT, UXA, BUYAN & MULLINS LLP 4 VENTURE, SUITE 300 IRVINE, CA 92618			SCHWARTZ, JORDAN MARC	
			ART UNIT	PAPER NUMBER
			2873	
DATE MAILED: 06/20/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/624,086

Applicant(s)

HO ET AL.

Examiner

Jordan M. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-21, 23-29 and 31-42 is/are rejected.
- 7) ☒ Claim(s) 10, 22, 30 and 43 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/15/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23 and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lieberman et al patent number 5,880,809.

Lieberman discloses the limitations therein including the following: a contact lens comprising a lens body (abstract); one of the anterior or posterior surface as a substantially smooth junctionless (Figures 8-9, column 11, lines 34-66); three dimensional asymmetrical surface (column 3, line 32 to column 4, line 11, column 11, lines 34-66); a varied surface topography with at least one contour that defines a substantially junctionless varying radial thickness (column 11, lines 34 to column 12, line 8 re substantially junctionless and Figures 8-9 which disclose the thickness of the lens varying radially and column 12, lines 1-7 re the peripheral portion shaped in the form of an S-curve which will cause the thickness of the peripheral portion to vary radially); and the varied surface topography facilitating lens comfort (column 12, lines 1-7). Lieberman further discloses the anterior surface can be a blended toric surface (column 10, lines 15-32); and the posterior and/or anterior surface as the substantially junctionless three dimensional surface (column 5, line 1 to column 8, line 52).

Lieberman discloses as is set forth above but does not specifically disclose the lens

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including a ballast by a varied anterior and/or posterior surface. However, the examiner takes Judicial Notice that it is well known in the art of contact lenses for contact lenses to have a varied anterior and/or posterior surface defining a ballast for the purpose of providing improved lens stability on the eye. Furthermore, Lieberman teaches that contact lenses can comprise a ballast for the purpose of providing increased lens stability (column 15, lines 8-50). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the contact lens of Lieberman et al as having a varied anterior and/or posterior surface defining a ballast since such a structure is well known in the art of contact lenses and is further taught by Lieberman with respect to prior art lenses for the purpose of providing a lens of improved stability on the eye.

Claims 1-9, 11-21, 24-25, 31-42 rejected under 35 U.S.C. 103(a) as being unpatentable over Lieberman et al patent number 5,880,809 in view of Baba et al publication number 2004/0039077.

With reference to claims 1-4, 7-9, 11-12, 15, 17-21, 24-25, 31-41, Lieberman discloses the limitations therein including the following: a contact lens (abstract) comprising a lens body including a soft hydrophilic or hydrogel material (column 15, lines 52-62); one of the anterior or posterior surface as a substantially smooth junctionless (Figures 8-9, column 11, lines 34-66); three dimensional asymmetrical surface (column 3, line 32 to column 4, line 11, column 11, lines 34-66); a varied surface topography with at least one contour that defines a substantially junctionless varying radial thickness (column 11, lines 34 to column 12, line 8 re substantially

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junctionless and Figures 8-9 which disclose the thickness of the lens varying radially and column 12, lines 1-7 re the peripheral portion shaped in the form of an S-curve which will cause the thickness of the peripheral portion to vary radially); and the varied surface topography facilitating lens comfort (column 12, lines 1-7). Lieberman discloses as is set forth above including that the lens material can be a soft hydrophilic or hydrogel material (column 15, lines 52-62) but does not specifically disclose this material as a silicone hydrogel or hydrophilic silicone polymer. Baba et al teaches that contact lenses made of soft hydrophilic or hydrogel material can specifically be made of silicone hydrogel or hydrophilic silicone polymer for the purpose of providing a contact lens of improved oxygen permeability and improved mechanical strength (paragraphs 0001-0012). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the soft hydrophilic or hydrogel contact lens of Lieberman as being specifically made of silicone hydrogel or hydrophilic silicone polymer since Baba et al teaches that contact lenses made of soft hydrophilic or hydrogel material can specifically be made of silicone hydrogel or hydrophilic silicone polymer for the purpose of providing a contact lens of improved oxygen permeability and improved mechanical strength. A hydrophilic silicone polymer lens will inherently absorb water since hydrophilic contact lenses in general inherently are able to absorb water. Lieberman further discloses the posterior and/or anterior surface as the substantially junctionless three dimensional surface (column 5, line 1 to column 8, line 52). Furthermore, with respect to the anterior surface, Lieberman et al discloses that the anterior surface can be a blended toric surface (column 10, lines 15-32). A toric surface

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will inherently be three dimensionally asymmetrical and a blended surface will inherently be smooth. Lieberman et al further discloses the lens body including a toric surface to correct an astigmatism (column 2, line 53, column 10, line 18); the posterior surface to approximate the curvature of the cornea (column 14, line 62); and the lens including a multifocal optical zone (column 15, line 33). The lens of Lieberman et al will inherently maintain a uniform distance between the corneal surface and the lens, this being reasonably based upon the similarity in structure between the lens of Lieberman et al and that of the claimed invention.

With reference to claims 13-14, Lieberman and Baba et al disclose and teach as is set forth above and Baba further teaches that the hydrophilic silicone polymer can further include at least one monomer of siloxane for the purpose of providing a contact lens of improved oxygen permeability and improved surface wettability (paragraphs 0001-0014). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the hydrophilic silicone polymer as including at least one monomer of siloxane since Baba further teaches of this feature for the purpose of providing a contact lens of improved oxygen permeability and improved surface wettability.

With reference to claims 5-6, 16, 35, and 42, Lieberman discloses as is set forth above but does not specifically disclose the lens including a ballast by a varied anterior and/or posterior surface. However, the examiner takes Judicial Notice that it is well known in the art of contact lenses for such lenses to have a varied anterior and/or posterior surface defining a ballast for the purpose of providing improved lens stability

on the eye. Furthermore, Lieberman teaches that contact lenses can comprise a ballast for the purpose of providing increased lens stability (column 15, lines 8-50). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the contact lens of Lieberman et al as having a varied anterior and/or posterior surface defining a ballast since such a structure is well known in the art of contact lenses and is further taught by Lieberman with respect to prior art lenses for the purpose of providing a lens of improved stability on the eye.

Claims 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Townsley patent number 5,020,898 in view of Baba et al publication number 2004/0039077.

With respect to claims 11-12 and 15, Townsley discloses the limitations therein including the following: a contact lens (abstract) comprising a lens body including a hydrophilic soft contact lens material (column 1, lines 42-52); the lens body having a toric surface (column 2, lines 35-44); a varied surface topography with at least one contour that defines a substantially junctionless varying radial thickness (column 2, lines 35-68 i.e. the thickness tapering in a smooth curve and Figures 2-4 which discloses the thickness varying radially); the varied surface topography facilitating lens comfort (column 2, lines 35-44); the lens structured to correct an astigmatism of the eye (abstract); and the varied surface topography provided on the anterior surface of the lens (column 2, line 45 to column 3, line 12). Townsley discloses as is set forth above including that the lens material can be a soft hydrophilic material (column 1, lines 42-52) but does not specifically disclose this material as a silicone hydrogel or hydrophilic

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silicone polymer. Baba et al teaches that contact lenses made of soft hydrophilic material can specifically be made of silicone hydrogel or hydrophilic silicone polymer for the purpose of providing a contact lens of improved oxygen permeability and improved mechanical strength (paragraphs 0001-0012). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the soft hydrophilic or hydrogel contact lens of Townsley as being specifically made of silicone hydrogel or hydrophilic silicone polymer since Baba et al teaches that contact lenses made of soft hydrophilic or hydrogel material can specifically be made of silicone hydrogel or hydrophilic silicone polymer for the purpose of providing a contact lens of improved oxygen permeability and improved mechanical strength. A hydrophilic silicone polymer lens will inherently absorb water since hydrophilic contact lenses in general inherently are able to absorb water.

With reference to claims 13-14, Townsley and Baba et al disclose and teach as is set forth above and Baba further teaches that the hydrophilic silicone polymer can further include at least one monomer of siloxane for the purpose of providing a contact lens of improved oxygen permeability and improved surface wettability (paragraphs 0001-0014). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the hydrophilic silicone polymer as including at least one monomer of siloxane since Baba further teaches of this feature for the purpose of providing a contact lens of improved oxygen permeability and improved surface wettability.



***Examiner's Comments***

Townsley is also be cited herein as support for the examiner's argument of inherency that a hydrophilic contact lens will inherently be water absorbing (Townsley, column 1, line 48).

***Response to Arguments***

Applicant's arguments concerning claims 10, 22, 30, and 43 have been considered and are persuasive. These claims are indicated as allowable as set forth below.

Applicant's arguments filed April 15, 2005 with respect to claims 23 and 26-29 have been fully considered but they are not persuasive. Specifically, applicant argues that Lieberman already achieves the desired positioning and alignment without ballast. However, as stated in the rejection above, the use of ballast is well known in the art of contact lenses and Lieberman further discusses the use of ballast thereby making obvious its use as stated above.

Applicant's arguments with respect to the other claims rejected above have been considered but are moot in view of the new ground(s) of rejection set forth above.

***Allowable Subject Matter***

Claims 10, 22, 30, and 43 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: with respect to the allowable subject matter, none of the prior art either alone or

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in combination disclose or teach of the claimed combination of limitations to warrant a rejection under 35 USC 102 or 103. Specifically, with respect to claims 10, 22, 30 and 43, none of the prior art either alone or in combination disclose or teach of the claimed contact lens having the specific lens structure and specifically including, as the distinguishing feature in combination with the other limitations, the claimed lens body configured to correct or reduce a wavefront aberration of the eye.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (571)

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272-2337. The examiner can normally be reached on Monday to Friday from 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jordan M. Schwartz  
Primary Examiner  
Art Unit 2873  
June 16, 2005